

PATENT COOPERATION TREATY

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07 SEP 2004

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

PCT

WRITTEN OPINION
(PCT Rule 66)

To:

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ATY RESP W.O. : Apr 28, 2004

Date of mailing
(day/month/year)

28. 01. 2004

Applicant's or agent's file reference
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REPLY DUE

within 3 month(s)
from the above date of mailing

International application No.
PCT/US 03/07036

International filing date (day/month/year)
06.03.2003

Priority date (day/month/year)
08.03.2002

International Patent Classification (IPC) or both national classification and IPC
B01D27/14

Applicant
DONALDSON COMPANY, INC.

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
 - I ☒ Basis of the opinion
 - II ☐ Priority
 - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
 - IV ☐ Lack of unity of invention
 - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
 - VI ☐ Certain documents cited
 - VII ☐ Certain defects in the international application
 - VIII ☐ Certain observations on the international application
3. The applicant is hereby **invited to reply** to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also: For an additional opportunity to submit amendments, see Rule 66.4. For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis. For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.
4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 08.07.2004

Name and mailing address of the international preliminary examining authority:



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I. Basis of the opinion

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

Description, Pages

1-21 as originally filed

Claims, Numbers

1-20 as originally filed

Drawings, Sheets

1/8-8/8 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

6. Additional observations, if necessary:

V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**1. Statement**

| | | |
|-------------------------------|--------|------------------|
| Novelty (N) | Claims | 1-3,5-13,20 (NO) |
| Inventive step (IS) | Claims | 1-13,16-20 (NO) |
| Industrial applicability (IA) | Claims | |

2. Citations and explanations**see separate sheet**

Re Item V

Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

- D1: US-A-3 000 505 (SCAVUZZO WILLIAM J) 19 September 1961 (1961-09-19)
D2: US-A-5 888 383 (COX IAN M) 30 March 1999 (1999-03-30)
D3: US-A-5 885 447 (LEGAULT KATHRYN A ET AL) 23 March 1999 (1999-03-23)

1- ARTICLE 33 (2) PCT - NOVELTY

The present application does not meet the requirements of Article 33(1) PCT, because the subject-matter of claims 1-3,5-13 and 20 is not new in the sense of Article 33(2) PCT.

1.1- The document D1 discloses (cf. page 2 line 3 - page 3; fig.1) a filter assembly comprising:

- a housing (1);
- a primary cylindrical filter element (5) positioned within the housing (1); The primary filter element (5) may be pleated.
- a secondary cylindrical filter element (6) completely circumscribed by the cylindrical extension of media of the primary filter element (5). The secondary filter construction comprises a porous screen.
- a bypass valve to selectively permit liquid flow to bypass the first filter (5) and to pass through the secondary filter element (6). Said bypass valve construction is completely circumscribed by the cylindrical extension of the primary filter element.

The subject-matter of claims 1,5,11,20 is therefore not new (Article 33(2) PCT).

1.2- The document D2 discloses (cf. column 1 lines 7-12; column 3 line 35 - column 4 line 11; column 5 lines 24-48; column 6 lines 23-48; figures) a filter assembly, which comprises in addition to document D1:

- a support structure on the inner side of the primary and secondary filter element;
- the screen of the secondary filter construction is a metal wire screen;
- the primary filter media support tube is spaced from the porous screen of the secondary filter to form an intermediate flow chamber therebetween;
- the porous screen of the secondary filter defines a tubular structure having a first open end piece and a second opposite closed end piece;
- the primary filter support tube has first and second ends, said first end of primary filter element support tube being secured to said first open end piece and said second end of said primary filter element support tube being spaced from, and extending axially beyond, said second closed end piece;

The subject-matter of claims 1-3,5-13,20 is therefore not new (Article 33(2) PCT).

2- ARTICLE 33 (3) PCT - INVENTIVE STEP

The present application does not meet the requirements of Article 33(1) PCT, because the subject-matter of claims 4,16,17,18,19 does not involve an inventive step in the sense of Article 33(3) PCT.

2.1- Independent apparatus claim 16

Document D2, which is considered to represent the most relevant state of the art, discloses a filter assembly from which the subject-matter of claim 16 differs in that the primary filter element comprises a fibrous media.

The problem to be solved by the present invention may therefore be regarded as to adapt the filtering performance and/or capacity of the filter assembly to the fluid to be filtered.

The solution proposed in claim 16 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT) for the following reasons:

The feature "using a fibrous media for the primary filter element" is a matter of normal design procedure. Its inclusion in the filter assembly described in document D2 would therefore be an obvious design possibility for the skilled person in order to solve the